



UNITED STATES PATENT AND TRADEMARK OFFICE

1/16
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/511,270

05/23/2005

Hidenori Nakajima

260617US0PCT

5020

22850 7590 12/20/2006
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

CARLSON, KAREN C

ART UNIT

PAPER NUMBER

1656

MAIL DATE

DELIVERY MODE

12/20/2006

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/511,270

Applicant(s)

NAKAJIMA ET AL.

Examiner

Karen Cochrane Carlson, Ph.D.

Art Unit

1656

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 November 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ They raise the issue of new matter (see NOTE below);

(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): 112, 1st paragraph scope of enablement and written description.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 20-28,30 and 44.

Claim(s) withdrawn from consideration: 29,31-43 and 45.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). 11/22/2006

13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because:

Applicants urge that Tang et al. disclose a huge genus of DNA sequences and does not specifically suggest the subgenus of polynucleotides that would bind WF00144. Tan et al. do disclose a polynucleotide encoding a polypeptide having 99.6% identity to SEQ ID NO: 2, and 96.6% sequence identity to the polynucleotide encoding SEQ ID NO:2, which is the nucleotide sequence of SEQ ID NO: 1. Therefore, the function of binding to WF00144 is an inherent property of the encoded polypeptide and Tang et al. remains art against the invention.

Applicants urge that Stausberg et al. disclose over 15,000 cDNA sequences and therefore discloses a huge genus of DNA sequences and does not specifically suggest the subgenus of polynucleotides that would bind WF00144. Tan et al. do disclose a polynucleotide encoding a polypeptide having 100% identity to SEQ ID NO: 2, and 96.6% sequence identity to the polynucleotide encoding SEQ ID NO:2, which is the nucleotide sequence of SEQ ID NO: 1. Therefore, the function of binding to WF00144 is an inherent property of the encoded polypeptide and Strausberg et al. remains art against the invention.

Applicants urge that Valenzuela et al. do not teach isolated nucleic acid sequences having at least 15 nucleotides of SEQ ID NO: 1. The claims recites "fragments consisting of at least" and is therefore the claim language is "open" inspite of the the phrase "consisting of".

The rejection of the Claims under 112, 1st para. for scope of enablment and for written description has been withdrawn because the specification teaches Riken, human, and rat polypeptides in the examples - see pages 37-38, for example - and one skilled in the art would align these closely related sequences and know where mutations could and could not be placed such that the structure and function of the polypeptide having SEQ ID NO: 2 would be maintained.



KAREN COCHRANE CARLSON, PH.D.
PRIMARY EXAMINER